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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/676,251	09/29/00	VADALA	J T0428/7090 T

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IM22/0517

EXAMINER

VO,H

ART UNIT	PAPER NUMBER
1771	4

DATE MAILED: 05/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/676,251

Applicant(s)

VADALA ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 34-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-33, drawn to an in-mold decorated article, classified in class 428, subclass 315.7.
  - II. Claims 34-59, drawn to a method for forming an in-mold decorated article, classified in class 426, subclass various.
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by extrusion or heat lamination.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert H. Walat on 05/09/01 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-7, 12, 13, 20-25, 27-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Keiser (US 5,851,617). Keiser discloses an article including a release liner sheet of microcellular foam material having an average cell size of less than 10 microns (see abstract) and a substrate joined to a surface of the release liner. See column 9, lines 1-19. The cell size range of the foam overlaps with the presently claimed ranges. Alternatively, for non-overlapping part of the ranges, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have altered the cell size range of the foam, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233. It would have been obvious to the skilled artisan to have optimized the cell size range of the foam, motivated by the desire to control the porosity of the foam. Therefore, it is the examiner's position that Keiser either anticipated or strongly suggested the claimed subject matter. With regard to claim 2, 3,

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Figure 1 of Keiser shows that the substrate is a single layer and comprises a fabric material (column 3, line 65). With regard to claim 5, Keiser suggests the substrate is woven or nonwoven fabric formed of natural fibers and /or filaments. See column 3, lines 62-63. With regard to claim 6, Keiser discloses the substrate comprises a plastic film. See column 3, lines 61. With regard to claim 7, Keiser discloses the microcellular polymeric material is formed by using supercritical fluid such as CO<sub>2</sub>, nitrogen, argon, helium. See column 5, lines 8-13. With regard to claims 12, and 13, Keiser teaches the polymeric material comprising polyethylene, acrylonitrile-butadienestyrene and substrate comprising polypropylene, polystyrene. See column 5, line 47, and column 6, 25-45. With regard to claim 22, Keiser discloses the substrate surface is embossed, colored or otherwise decorated. See column 6, lines 60-61.

With regard to claim 29, Keiser teaches the substrate, itself, can be a sheet of microcellular foam material. See column 5, line 47. The substrate is polymer foam. See column 3, line 62.

8. Claims 4, 9-11, 14-16, 17-19, 26, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keiser (US 5,851,617). Keiser discloses the substrate having a thickness of from 0.5 to 100 mm ( 0.02 to 3.94 inch). See column 5, lines 50-51. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have altered the thickness range of the substrate, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233. It would have been obvious to the skilled artisan to have optimized the

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thickness range of the substrate the motivated by the desire to control the degree of adherence of the substrate to the foam layer.

With regard to claims 9-11, and 31-33, Keiser broadly suggests to use a polypropylene fabric with polypropylene microcellular (or any like combination). See column 3, lines 59-63. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a polypropylene fabric with polypropylene microcellular (or any like combination) motivated by the desire to obtain a laminate which could be easily recycled.

With regard to claim 16, Keiser discloses an article having a release liner/adhesive/substrate structure. See column 9, line 1. The substrate has a thickness of from 0.5 mm to 100 mm (0.02 inch to 3.94 inch). See column 5, lines 50-51. The release liner has a thickness of from 30 to 3000 nm. See column 5, line 28. It is the examiner's position that the article having a thickness of from 0.5 mm to 103 mm (0.02 inch to 4 inch). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have altered the thickness range of the article, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233. It would have been obvious to the skilled artisian to have optimized the thickness range of the article motivated by the desire to control the degree of adherence of the substrate to the foam layer.

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With regard to claims 14, 15, Keiser discloses the foam material provides a wide range of void fraction percentages from very high void fractions (low material density) up to 90%, or more, to very low void fractions (high material density) down to 20%, or less. See column 4, lines 57-61. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have altered the void fraction percentage range of the foam, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233. It would have been obvious to the skilled artisan to have optimized the void fraction percentage range of the foam motivated by the desire to control the porosity of the foam.

With regard to claims 17-19, Keiser does not specially disclose the length-to-thickness ratio of the article. It would have been an obvious matter of design choice to have altered the length-to-thickness ratio of the article, since such a modification would have involved a mere change in the size of the article. A change in size is generally recognized as being within the level of ordinary skill in the art. In *re Rose*, 105 USPQ 237 (CCPA 1955).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiser (US 5,851,617) in view of Smorada et al (US 4,961,983). Keiser does not specially disclose a substrate being polypropylene fabric. Smorada teaches in analogous art, the substrate being polypropylene fabric. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used polypropylene fabric as a

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substrate in the Keiser article motivated by the desire to provide the highest yield at the lowest cost.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiser (US 5,851,617) in view of Closson (US 5,948,711). Keiser does not teach the substrate adhered to the surface of the microcellular polymeric material in the absence of an external adhesive. Closson discloses the lamination of a polypropylene film bonded to a propylene fabric layer by extruding. See example. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have bonded polymeric material layer to the substrate without using any adhesives, motivated by the desire to recycle the article.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3601.




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HV

May 14, 2001



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